REMARKS

In response to the final Office Action dated April 20, 2006, the Assignee respectfully requests continued examination based on the above amendments and the following remarks. The Assignee respectfully submits that the pending claims distinguish over the cited document to *Marsh*.

Claims 1-6, 8-9, 11-15, and 17-20 are pending in this application.

Claims 1, 3-10, 12-18, and 20 were rejected under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent 5,848,397 to Marsh *et al.* Claims 2, 11, and 19 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Marsh*.

The Assignee shows, however, that the pending claims distinguish over the cited document to *Marsh*.

Rejection of Claims under § 102

Claims 1, 3-10, 12-18, and 20 were rejected under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent 5,848,397 to Marsh *et al.* A claim is anticipated only if each and every element is found in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter "M.P.E.P.").

Claims 1, 3-10, 12-18, and 20 are not anticipated. These claims recite features that are not disclosed by *Marsh*. Claim 1, for example, recites "*receiving programming content delivered as a scheduled lineup having an advertisement inserted into a future advertisement time slot.*" Support for such features may be found at least at page 7, lines 3-4 and at lines 9-10 of the as-filed application. Moreover, claim 1 also recites "*receiving an advertiser's request to replace the*

prescheduled advertisement with a different advertisement." Support for such features may be found at least at page 8, lines 20-21 of the as-filed application. Independent claim 1 is reproduced below, and independent claims 9 and 17 recite similar features.

1. (Currently Amended) An advertisement management method, comprising:

receiving programming content delivered as a scheduled lineup having an advertisement inserted into a future advertisement time slot;

categorizing the prescheduled advertisement as at least one of an overrideable advertisement and a non-overrideable advertisement, wherein the overrideable advertisement is replaceable with another advertisement, and wherein the non-overrideable advertisement is not replaceable and will be delivered as scheduled;

receiving an advertiser's request to replace the prescheduled advertisement with a different advertisement;

determining whether the prescheduled advertisement is categorized as overrideable; and

if the prescheduled advertisement is categorized as an overrideable advertisement, then replacing the prescheduled advertisement with the different advertisement.

Marsh fails to anticipate these features. No where does *Marsh* disclose "*receiving programming content delivered as a scheduled lineup having an advertisement inserted into a future advertisement time slot.*" The patent to Marsh *et al.*, instead, receives advertisements when email is retrieved, and those advertisements are then sorted and scheduled. *See, e.g.*, U.S. Patent 5,848,397 to Marsh *et al.* (Dec. 8, 1998) at column 13, lines 55-65. *Marsh* also does not disclose "*receiving an advertiser's request to replace the prescheduled advertisement with a different advertisement.*" Because *Marsh* does not disclose "*a scheduled lineup having an advertisement inserted into a future advertisement time slot,*" the patent to Marsh *et al.* also fails to disclose "*replac[ing] the prescheduled advertisement with a different advertisement.*"

Marsh, then, cannot anticipate claims 1, 3-10, 12-18, and 20. Because *Marsh* fails to disclose many features recited in these claims, Examiner Van Bramer is respectfully requested to remove the § 102 (e) rejection of claims 1, 3-10, 12-18, and 20.

Rejection of Claims under 35 U.S.C. § 103 (a)

Claims 2, 11, and 19 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Marsh*. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P.").

1. **The Proposed Combinations Do Not Teach or Suggest All the Features of the Independent Claims, so the § 103 (a) Rejections are Improper**

Claims 2, 11, and 19 are not obvious. These claims all recite, or incorporate, features that are not taught or suggested by *Marsh*. These claims, for example, incorporate "*receiving programming content delivered as a scheduled lineup having an advertisement inserted into a future advertisement time slot*." These claims also incorporate "*receiving an advertiser's request to replace the prescheduled advertisement with a different advertisement*." Claims 2, 11, and 19, then, cannot be obvious over *Marsh*.

Moreover, the patent to Marsh *et al.* also fails to teach or suggest claims 2, 11, and 19. Claims 2 and 11 recite "*receiving a premium to replace the scheduled overrideable advertisement*," while claim 19 recites "*wherein the overrideable advertisement is priced at a lower cost than the scheduled non-overrideable advertisement*." No where does *Marsh* disclose, or suggest, such a premium. Examiner Van Bramer even admits that *Marsh* fails to "explicitly state" that an advertisement's priority is based on cost. While Examiner Van Bramer states that "length of time" and "number of exposures" has been historically linked with cost, claims 2, 11, and 19 recite a premium/cost to override a scheduled advertisement. *Marsh* is completely silent to such features, so the *prima facie* case for obviousness must fail.

2. Because No Reasonable Expectation of Success was Cited, the § 103 (a) *Prima Facie* Case for Obviousness Is Improper

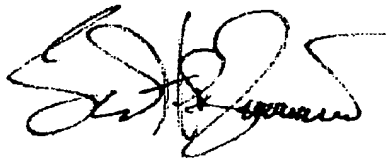
The Examiner's *prima facie* case for obviousness is defective. The Examiner's *prima facie* case for obviousness must include "a reasonable expectation of success." DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition). Here, however, the Examiner's *prima facie* case wholly fails to include any expectation of success. The Examiner, then, has failed to carry the burden, so the *prima facie* case for obviousness must fail. The Assignee thus respectfully asserts that the § 103 (a) rejection of claims 2, 11, and 19 must be removed.

3. There Can Be No Reasonable Expectation of Success, so Claims 2, 11 & 19 Cannot be Obvious

Marsh cannot support a reasonable expectation of success. Because *Marsh* fails to disclose the features recited in claims 2, 11, and 19, one of ordinary skill in the art would not expect success to modify *Marsh*, as Examiner Van Bramer asserts. The *prima facie* case for obviousness fails, so the § 103 (a) rejection of claims 2, 11, and 19 should be removed.

If any questions arise, the Office is requested to contact the undersigned at (919) 387-6907 or scott@wzpatents.com.

Respectfully submitted,



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